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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/062,855 | 01/31/2002 | Toma Udiljak | 1947-00101 | 1226 |
| 23505 | 7590 | 02/27/2006 | EXAMINER | |
| CONLEY ROSE, P.C. | | | O'CONNOR, GERALD J | |
| P. O. BOX 3267 | | | ART UNIT | |
| HOUSTON, TX 77253-3267 | | | PAPER NUMBER | |
| | | | 3627 | |

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/062,855

Applicant(s)

Udijak et al.

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on August 24, 2005 and December 15, 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 10-24, 28, 30-33, and 36-43 is/are pending in the application.
- 4a) Of the above claim(s) 1-5, 31-33, 36-39, and 43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-24, 28, 30, and 40-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on January 31, 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Preliminary Remarks

1. This Office action responds to the amendment and arguments filed by applicant on August 24, 2005 in reply to the previous Office action on the merits, mailed February 24, 2005, and to the election filed by applicant on December 15, 2005 in reply to the Office action setting forth a requirement for restriction, mailed November 16, 2005.

2. The amendment of claims 1, 10, 18, 28, 30, 31, and 36; cancellation of claims 6-9, 25-27, 29, 34, and 35; and addition of claims 39-43, in the reply filed by applicant on August 24, 2005, are all hereby acknowledged.

Election/Restriction

3. Applicant's election without traverse of the invention of Group II, claims 10-24, 28, 30, and 40-42, in the reply filed December 15, 2005 is hereby acknowledged.

4. Claims 1-5, 31-33, 36-39, and 43 are hereby withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed December 15, 2005.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

6. Claims 10-14, 18, 22-24, 28, 30, and 40-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Jared (US 6,865,442).

Jared discloses a method of producing custom orthotic insoles, comprising: receiving into a computer system an order for custom orthotic insoles; each order comprising scanned images of a patient's foot and instructions on customizing the orthotic insole, said instructions incorporating prescription information based on a diagnosis from a practitioner; converting the scanned images into three dimensional orthotic insole computer models; adding features to the orthotic insole computer model according to the instructions for customizing the orthotic insole; generating fabrication instructions for creating a physical replica of the orthotic insole computer

model; and fabricating a physical replica of the orthotic insole computer model using the fabrication instructions. See, in particular, column 1, lines 20-37.

Regarding claim 11, in the method of Jared, the top surface of the orthotic insole computer model is created from the foot computer model.

Regarding claims 12 and 30, in the method of Jared, the instructions on customizing the orthotic insole are prescription instructions from a medical practitioner.

Regarding claim 13, the method of Jared further comprises: creating a patient record in a production database for each customer that has placed an order for custom orthotic insoles; and storing all order information with the corresponding patient record; wherein all order information is retrievable from the production database.

Regarding claim 14, in the method of Jared, patient record information within the production database is viewable using a production database explorer software program.

Regarding claims 22-24, in the method of Jared: the order is placed by the end user; the order is placed for the end user by an authorized practitioner; and, the authorized practitioner is a medical doctor and the custom fabrication instructions are in the form of a prescription generated in response to a medical diagnosis.

Regarding claims 40-42, in the method of Jared, the step of adding features to the orthotic insole computer model includes executing at least one function selected from the group consisting of functions for creating pads on the surface of the insole, functions for creating recesses to alleviate pressure on injured or irregular surfaces of the foot, functions for elevating parts of the insole, functions for generating new surfaces defined by multiple points

interconnected by lines, functions for raising or depressing an area defined polygonally by setting points on the surface of the insole, functions for adding outer support to the longitudinal arch area, functions for modifying the thickness of the insole, functions for altering the lateral tilt, functions for defining the heel of the insole, and functions for eliminating uneven surfaces created during the scanning procedure.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 15-17 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jared (US 6,865,442).

Jared discloses a method of producing custom orthotic insoles, as applied above in the rejection of claims 10-14 under 35 U.S.C. 102(e), but Jared fails to specifically disclose scanning the foot using any of: a foot pressure measuring device; an internal foot structure imaging device; or, a laser scanning device. However, all three types of scanning devices are certainly well known, hence obvious, to those of ordinary skill in the art of orthotics, and official notice to that effect is hereby taken. Therefore, it would have been obvious to one of ordinary skill in the

art, at the time of the invention, to have modified the method of Jared so as to include that the scanning of the foot would be accomplished using any of: a foot pressure measuring device; an internal foot structure imaging device; or, a laser scanning device, as is well known to do, the selected off-the-shelf device being chosen merely as a matter of design choice, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claims 19-21, Jared discloses a method of producing custom orthotic insoles, as applied above in the rejection of claim 18 under 35 U.S.C. 102(e), but Jared fails to specifically disclose any of: downloading the foot-scan software from the orthotic insole manufacturer; that the foot-scan software produces queries and provides instructions for the user of the software; and, that the scanned data/order file can be submitted to the orthotic insole manufacturer by means of e-mail. However, all three of these recited elements of functionality are well known, hence obvious, to those of ordinary skill in the art, and official notice to that effect is hereby taken. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Jared so as to include that the foot-scan software could be obtained by downloading the software from the orthotic insole manufacturer; that the foot-scan software would produce queries and provide instructions for the user of the software; and, that the scanned data/order file could be submitted to the orthotic insole manufacturer by means of e-mail, as is well known to do, the functionality being provided merely as a matter of design choice, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Response to Arguments

9. Applicant's arguments filed August 24, 2005 have been fully considered but they are not deemed persuasive.

10. The arguments regarding the previous prior art rejections have been considered, but have been rendered moot by applicant's amendment, and the consequent new grounds of rejection.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to the disclosure.

12. Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Alexander Kalinowski, can be reached at **(571) 272-6771**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (571) 273-8300**. Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

February 16, 2006

 2/16/06

Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627